

Translation

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY  
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference <b>PAT 0918 PCT</b>	<b>FOR FURTHER ACTION</b>		See Form PCT/IPEA/416
International application No. <b>PCT/DE2004/000089</b>	International filing date (day/month/year) <b>22.01.2004</b>	Priority date (day/month/year) <b>27.01.2003</b>	
International Patent Classification (IPC) or national classification and IPC <b>G01N 30/60</b>			
Applicant <b>SLS MICRO TECHNOLOGY GMBH</b>			

<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <b>6</b> sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input type="checkbox"/> (<i>sent to the applicant and to the International Bureau</i>) a total of _____ sheets, as follows:</p> <p><input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (<i>sent to the International Bureau only</i>) a total of (indicate type and number of electronic carrier(s)) _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>																								
<p>4. This report contains indications relating to the following items:</p> <table> <tr> <td><input checked="" type="checkbox"/></td> <td>Box No. I</td> <td>Basis of the report</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. II</td> <td>Priority</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. III</td> <td>Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. IV</td> <td>Lack of unity of invention</td> </tr> <tr> <td><input checked="" type="checkbox"/></td> <td>Box No. V</td> <td>Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability, citations and explanations supporting such statement</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. VI</td> <td>Certain documents cited</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. VII</td> <td>Certain defects in the international application</td> </tr> <tr> <td><input checked="" type="checkbox"/></td> <td>Box No. VIII</td> <td>Certain observations on the international application</td> </tr> </table>	<input checked="" type="checkbox"/>	Box No. I	Basis of the report	<input type="checkbox"/>	Box No. II	Priority	<input type="checkbox"/>	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability	<input type="checkbox"/>	Box No. IV	Lack of unity of invention	<input checked="" type="checkbox"/>	Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability, citations and explanations supporting such statement	<input type="checkbox"/>	Box No. VI	Certain documents cited	<input type="checkbox"/>	Box No. VII	Certain defects in the international application	<input checked="" type="checkbox"/>	Box No. VIII	Certain observations on the international application
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Date of submission of the demand	Date of completion of this report
Name and mailing address of the IPEA/	Authorized officer
Facsimile No.	Telephone No.

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/DE2004/000089

## Box No. I Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.

This report is based on translations from the original language into the following language \_\_\_\_\_, which is the language of a translation furnished for the purposes of:

international search (Rule 12.3 and 23.1(b))  
 publication of the international application (Rule 12.4)  
 international preliminary examination (Rule 55.2 and/or 55.3)

2. With regard to the elements of the international application, this report is based on (*replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report*):

the international application as originally filed/furnished  
 the description:

pages 1-14 as originally filed/furnished

pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_

pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_

the claims:

nos. 1-14 as originally filed/furnished

nos.\* \_\_\_\_\_ as amended (together with any statement) under Article 19

nos.\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_

nos.\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_

the drawings:

sheets 1/2-2/2 as originally filed/furnished

sheets\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_

sheets\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_

a sequence listing and/or any related table(s) – see Supplemental Box Relating to Sequence Listing.

3.  The amendments have resulted in the cancellation of:

the description, pages \_\_\_\_\_  
 the claims, nos. \_\_\_\_\_  
 the drawings, sheets/figs \_\_\_\_\_  
 the sequence listing (*specify*): \_\_\_\_\_  
 any table(s) related to sequence listing (*specify*): \_\_\_\_\_

4.  This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

the description, pages \_\_\_\_\_  
 the claims, nos. \_\_\_\_\_  
 the drawings, sheets/figs \_\_\_\_\_  
 the sequence listing (*specify*): \_\_\_\_\_  
 any table(s) related to sequence listing (*specify*): \_\_\_\_\_

\* If item 4 applies, some or all of those sheets may be marked "superseded."

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

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Box No. V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

## 1. Statement

Novelty (N)      Claims 1-14      YES

Claims \_\_\_\_\_ NO

Inventive step (IS)

Claims \_\_\_\_\_ YES

Claims 1-14 NO

Industrial applicability (IA)

Claims 1-14 YES

Claims \_\_\_\_\_ NO

## 2. Citations and explanations (Rule 70.7)

In this opinion reference is made to the following documents:

D1: WO 99/24828 A (PERKIN ELMER CORP) 20 May 1999  
(1999-05-20)

D2: WO 98/54568 A (PERSEPTIVE BIOSYSTEMS INC)  
3 December 1998 (1998-12-03)

Independent claim 1 contains a number of points that are seriously unclear (see Box VIII). Insofar as independent claim 1 can be understood, it does not involve an inventive step (PCT Article 33(3)). Thus the present application does not satisfy the requirements of PCT Article 33(1).

D1 is considered to be the prior art closest to the subject matter of claim 1. Said document discloses the problem of the racetrack effect addressed by the application (page 1, lines 28-34), a serpentine miniaturised separation column (figure 1), and calculations which correlate the channel width and radius of curvature with migration of the species (see e.g. page 6, lines 5-9).

Box No. V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

The subject matter of claim 1 therefore differs from that known from D1 in that a miniaturised separation column is used for a gas chromatograph.

The problem addressed by the present invention can therefore be considered that of adapting a microchip designed for electrophoresis so that it can be used in gas chromatography.

D2 (see page 1, lines 9-14) discloses that microstructures can be used for both electrophoresis and chromatography.

A person skilled in the art would therefore combine all the features disclosed in D1 and D2 to solve the problem of interest without thereby being inventive.

Consequently, the solution proposed in independent claim 1 cannot be regarded as inventive (PCT Article 33(3)).

Dependent claims 2-14 relate to embodiments of the separation column defined in claim 1, of the kind that a person skilled in the art routinely makes on the basis of familiar considerations, especially since the resulting advantages are readily foreseeable. Consequently, the subject matter of claims 2-14 also fails to satisfy the requirements for inventive step.

The applicant's arguments concerning D1, in terms of the diffusion path of a species molecule, relate to a feature which is not clearly defined (see Box VIII) or to the

**INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY**

International application No.

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**Box No. V****Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

angles of curvature and uniformity of the channel diameters of the separation channel. These features are not mentioned in claim 1 and cannot be cited for the assessment of inventive step in respect of the features in claim 1.

## Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

The characterising part of claim 1 attempts to define the separation column in terms of features of the species to be analysed. A definition of this kind is not admissible, since the claim relates to the separation column alone and a person skilled in the art cannot detect from the separation column which species is being analysed therein. Claim 1 is therefore unclear (PCT Article 6).

The applicant argues that claim 1 is clearly worded, since a person skilled in the art would be in no doubt as to the subjects to be covered by the claim. This view is unconvincing. Although the concepts used in claim 1 are clearly expressed, the diffusion length of a molecule in a separation column is dependent on temperature, pressure and the type of molecule, as well as on the carrier gas and packing in the column (see also page 5, lines 12-21 of the description in the present application). As a result of this large number of unknown parameters, the size of the claimed channel diameter is vague, thus leading to an unclear claim.